Supreme Court, U.S.
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No. 92-1683

IN THE

Supreme Court of the United States

OCTOBER TERM, 1992

JENNMAR CORPORATION,

Petitioner,

v.

PATTIN MANUFACTURING COMPANY,

and

BIRMINGHAM BOLT COMPANY,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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STATEMENT PURSUANT TO RULE 29.1

All parties to the proceeding below are set forth in the caption to the case. Respondent Birmingham Bolt Company has been merged into its parent corporation Birmingham Steel Corporation, a public corporation. Respondent Pattin Manufacturing Company was until 1987 an unincorporated division of The Eastern Company, a public corporation. In 1987, the assets of Pattin were sold to Birmingham Bolt.

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OPINIONS BELOW

The *per curiam* Opinion of the Federal Circuit Court of Appeals is noted in 985 F.2d 583 (1992).

The district court issued two separate opinions in this case in which summary judgment against Petitioner was granted. Four different patents allegedly infringed by Respondents were addressed. The Petition seeks to bring before this Court only a portion of the second 1991 Opinion. (20 U.S.P.Q. 2d (B.N.A.) 1721; App. A3) The 1989 Opinion addressed similar issues, and analyzed Pattin's "Double Lock" bolt which was the accused mine bolt system. The 1989 Opinion was referenced at certain points in the trial court's 1991 Opinion, and is referenced in the Petition at page 8. That earlier Opinion was reported at 12 U.S.P.Q. 2d (B.N.A.) 1321 (S.D. Ohio 1989).

STATEMENT OF THE CASE

A. PROCEDURAL HISTORY.

Petitioner Jennmar Corporation sued Respondent Pattin Manufacturing Co. in May 1984, alleging that the Double Lock® bolt, but not all mine roof bolts, manufactured and sold by Pattin infringed two patents issued to Jennmar President Frank Calandra. An accountant by training, Calandra thereafter received two additional, related patents for mine roof bolts which were added to the lawsuit in July 1985.

Intensive pretrial discovery followed. Hundreds of interrogatories and requests for admission were answered by Pattin, thousands of pages of documents were produced, and dozens of witnesses were deposed. Among the witnesses were three employees of DuPont, the manufacturer of a mine resin cartridge

commonly used with mine roof bolts, including the Double Lock bolt.

Relying primarily upon an expert Affidavit from the managing director of Pattin, and upon deposition testimony and test reports of the DuPont witnesses, Pattin moved for summary judgment on the first two Calandra patents [numbers '930 and '805] in February 1987. Following briefing and oral argument, Chief Judge John D. Holschuh granted Pattin's motion in a 35 page opinion which found neither patent infringed. 12 U.S.P.Q. 2d (B.N.A.) 1321. (May 1, 1989)

Summary judgment was then sought on the two remaining Calandra patents [numbers '885 and '292]. Chief Judge Holschuh granted summary judgment of noninfringement on the last two patents. (App. A3)

Following resolution of a counterclaim on an unrelated mine roof bolt patent, now expired, appeal to the Federal Circuit Court of Appeals followed. That court affirmed in a one-line *per curiam* Opinion released a week after argument. Jennmar's rehearing request was denied, as was its suggestion for *in banc* review. (App. A49) This Petition followed.

B. STATEMENT OF FACTS.

Here, as in the district court and the Federal Circuit, Petitioner disregards decades of prior art in the field of mine roof bolting. The district court, however, fully appreciated the vast prior art background to the Calandra patents when it found:

> Mine roof bolts have been known in the art of mine roof support to anchor in bore holes drilled in a mine roof to reinforce the unsupported rock above the roof. *It is un-*

> *disputed that mine roof bolts combining mechanical and resin anchoring are included in the prior art.* It is also undisputed that the prior art teaches that resin will be mixed, in part, by the mere placement of the bolt into the bore hole. Prior art includes a bolt having a threaded end portion; a camming plug having an internally threaded bore and an outer surface, said camming plug threadedly engaged to the threads adjacent the end of said bolt threaded end portion, said camming plug positioned to move axially on said bolt upon rotation of said bolt in a preselected direction; an expandable shell having a plurality of longitudinally extending fingers each having an inner surface and an outer surface, a portion of said inner surface abutting a portion of the camming plug outer surface and a portion of the finger outer surface adapted to engage the wall of a bore hole; expandable shell fingers arranged to expand outwardly to engage the outer surface of the fingers to the wall of a bore hole by longitudinal movement of the camming plug relative to the bolt threaded end portion and the expandable end portion and the expandable shell; and a means for moving the camming plug axially on the bolt threaded end portion. (App. 15-16) (emphasis added.)

When all four Calandra patents were issued in the early 1980's, this was a crowded art. Even the Calandra '885 patent acknowledged that its "shell member [is] conventional in design." (Suppl. App., col. 7, lines 15-16.)

Beginning at least as early as 1958, those of ordinary skill in this art knew that conventional mine roof bolts could be installed with resin cartridges. Further advances followed through the 1960's and 1970's, as professional literature appeared and United States patents issued on bolts and bolting systems using resin. Chemical manufacturers, such as DuPont, worked independently to perfect both the resin and the plastic cartridges used to contain resin as it was inserted with the metal bolts into holes drilled into the mine roof. These developments were summarized by expert witness George Vass in an affidavit submitted in 1987:

> Basic, conventional mine bolt designs have remained substantially unchanged since the 1950's, with the exception of things like David Hill's invention in the mid-1970's. Apart from the fact changes in bolt designs are infrequent, I also know coal mining companies and coal miners generally are resistant to changing to new bolt designs once they have a bolt in which they have confidence for a particular mine.

(Ct. Appeals Jt. Appendix, p. A387.)

Prompted by Jennmar to perform tests, DuPont analyzed Pattin's Double Lock bolt. DuPont reached conclusions contrary to Jennmar's position, and its evidence confirmed that there was no "*reliable* means or method of maintaining the expansion shell in an unexpanded condition. . .to mix the resin" as '885 required. (App. A46; emp. original.)

SUMMARY OF THE ARGUMENT

The district court properly considered the distinctions between Petitioner's method claims and the accused Double Lock bolts, and correctly concluded that infringement was avoided because there was no structure which reliably assured rotation of the mechanical expansion shell with the bolt to mix resin. The Federal Circuit Court of Appeals implicitly adopted the findings and legal conclusions of the district court when a distinguished panel of that court summarily affirmed that opinion (App. A1).

The question presented seeks merely to apply an otherwise well-entrenched legal principle to facts specific to the case. Clarification of an otherwise clear line of legal authority need not occur. The disputed point, even if resolved in Petitioner's favor, will affect only the parties at bar.

ARGUMENT

A. THE DISTRICT COURT FOLLOWED PROPER METHODOLOGY FOR INTERPRETING PATENT CLAIMS.

Petitioner does not dispute that the district court set forth the proper methodology for interpreting the claims of the '885 patent. (App. 35-37) As noted by the district court (App. A14-15), "[t]he threshold requirement in claim construction is an examination of the claims at issue because it is the claim which measures the invention. *Aro Manufacturing Co., Inc. v. Convertible Top Replacement Co., Inc.*, 365 U.S. 336, 339 (1961)." Petitioner's only dispute is with the result achieved, and not the law applied to reach that result. Petitioner's argument, when stripped to its

essence, concerns the highly fact specific application of its patent claims to the Double Lock[1].

B. A MINE ROOF BOLT IS A MANUFACTURE AND PETITIONER HAD THE BURDEN OF SHOWING HOW IT PERFORMED THE STEPS OF THE METHOD.

Petitioner has accused a "manufacture", namely a mine roof bolt, of carrying out the various steps of its method claims. It cannot seriously be disputed that the Double Lock bolt is manufactured from a number of structural parts or elements which the district court recognized were old in the mine roof support art, and which had been assembled in that same manner since long prior to the filing date of Petitioner's patents. Of course, patents may be lawfully granted only on that which is new, useful, and unobvious; 35 U.S.C. § 101, *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966). Hence, the courts below necessarily focused upon the improvement disclosed and claimed in Petitioner's patent.

Petitioner does not dispute that means such as the shear pin, prominently referenced in its patent, will, if used, assure predictable rotation of the otherwise prior art expansion shell when mounted to the oth-

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[1] Almost one page of the Petition is devoted to describing the invention by reference to the drawing figures and specification describing its mine roof bolt (Petition, p. 3). Additional discussion is directed to the Double Lock bolt (Petition, pp. 4-5). Little, if any, discussion explains the claimed method invention, the only invention under consideration.

Respondents sell mine roof bolts, articles of manufacture, as are the patented bolts. Thus, while Petitioner directs this Court's attention to its "bolt" when explaining its invention, it criticizes the courts below for looking to that bolt when construing the claims covering its method of installation.

erwise prior art bolt, Petition, p. 3. A shear pin is the structural element which Petitioner, but not Respondents, utilized to cause its improved results to be achieved.

Petitioner's '885 method claims are directed to a series of steps or acts, all having the purpose of anchoring its bolt. The steps employ verbs to explain and set forth what is occurring during the anchoring process. Verbs are action words, and it was Petitioner's burden to explain to the courts below how the parts of the Double Lock bolt performed the claimed actions, *SRI Intern. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1123 (Fed. Cir. 1985). By the very nature of the charges made by Petitioner, the courts below were obligated to look to the Double Lock bolt when determining whether its structural components, either singularly or cooperatively, performed those actions.

Because the actions were not performed, there could be no infringement, *Royer v. Coupe*, 146 U.S. 524, 533 (1892).

C. THE '885 PATENT IS A NARROW ONE IN A CROWDED ART.

While Petitioner seeks to have its '885 claims construed as if they arise from a pioneer invention, *Westinghouse v. Boyden Power Brake Co.*, 170 U.S. 537, 562 (1898), the field was quite crowded when the Calandra application was filed.[2] Petitioner does not dispute the district court's characterization of the field

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[2] The district court explicitly found that construing the claims as not requiring some tangible means like the shear pin would cause them to unlawfully encompass the prior art. (App. A47-48).

in its Opinion at App. 15-16. Under the law, the '885 claims must be construed with that prior art as a necessary background, *Tilghman v. Proctor*, 102 U.S. 707, 710 (1880).

This Court's opinion in *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471 (1944), effectively lays to rest Petitioner's argument that a process patent in a crowded art may be construed to cover the use of substantially different apparatus. In *Universal Oil Products*, the Court considered a method invention in a "crowded art", *id.* at 484, and held:

> [w]hile varying the details of a process does not avoid infringement, Tilgham v. Proctor, 102 U.S. 707, 26 L. Ed. 279, *when the accused process does not substantially follow the mode taught in the patent, there is no infringement.* (Emphasis added).

Id. at 485.

The courts below construed Petitioner's claims as employing a mode using a shear pin or some other tangible, displaceable structure having the purpose of assuring predictable rotation of the shell with the bolt in order to mix the resin (App. A46-A47). The district court found that the Double Lock bolt not only lacked the structural elements which could permit that mode to be employed, but that Petitioner failed to produce any evidence that the alleged equivalent, friction between parts, would assure predictable rotation, *Celotex Corp. v. Catrett*, 477 U.S. 316, 322 (1986).[3] Of

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[3] "Where the questions presented by the contested claims of infringement. . .are purely factual, this Court ordinarily accepts

course, mere friction of parts on a conventional mine bolt was long known in this art, and was not invented by Calandra.

D. THE "NEW" RESIN IS A NEW ISSUE.

Petitioner vainly attempts to recast the friction theory (which the district court recognized came up late in this case as "a new theory of equivalence", App. A40), by only now arguing that infringement is made out because the Double Lock bolt "uses a new, less viscous resin and competes directly in the marketplace with Jennmar's patented bolt." (Petition, p. 5.) In its Brief to the Federal Circuit, Petitioner stated to the contrary that the Double Lock "uses the same type of resin cartridge". (Brief at 6) In view of Supreme Court Rule 15.1, the Petition should not be granted upon the mistaken belief that the issue presented could be decided.

Moreover, Petitioner's approach runs afoul of the recognized rule that competition in the marketplace is not to be restrained by unlawfully extending the patent monopoly, *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 12 (1946).

E. NO NATIONAL INTERESTS ARE AT STAKE.

It is readily apparent from the detailed analysis made by the district court and adopted by the court of appeals that the question Petitioner presents is highly fact specific and of interest largely, if not exclusively, to only the parties at bar. While Petitioner hypothesizes that matters of great national interest are at stake, Petition, p. 25 *et seq.*, nothing of the

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the concurrent conclusions of the district court and Circuit Court of Appeals". *Universal Oil Products, supra.* at 473.

sort is supported by the record. For example, Respondents each manufactured their version of the Double Lock bolt in the United States, so the Process Patent Amendment Act of 1988 (Petition, p. 26) is not applicable. Furthermore, considering that that Act was concerned with the extraterritorial making of an article subsequently imported into the United States, it is not apparent how the Act applies to a "method of anchoring a bolt in a bore hole". The claimed method is to use of the article, and not to its method of manufacture.

F. THERE IS NO CONFLICT BETWEEN THE PANELS OF THE FEDERAL CIRCUIT.

Petitioner also makes too much of the Federal Circuit Court of Appeals decision in an unrelated case, *Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 970 F.2d 834, *reh'q denied*, 974 F.2d 1279 (1992) (Petition, pp. 19-20), because the decision there involved "product-by-process claims", *id* at 846-847. Those sorts of claims are not presented here.

Similarly, while Petitioner strains to suggest that as a matter of course panels of the Federal Circuit Court of Appeals are in conflict, no conflict is apparent on this record nor does one exist. As noted, Petitioner raised this point below and requested rehearing and *in banc* review, and yet both were summarily denied without dissent. (App. A49) The appeals court thought so little of this point that no opinion was deemed necessary. Certainly some member of the Federal Circuit Court of Appeals would have recognized this conflict had one existed.

CONCLUSION

For the reasons stated, the Petition should be denied.

Respectfully submitted,

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